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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/258,123 | 02/26/1999 | ROBERT T. BURGER | 107227.00102 | 3397 |

7590 02/27/2003

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EXAMINER

ROBINSON, GRETA LEE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2177

24

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/258,123

Applicant(s)

BURGER ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-84 are pending in the present application.
2. Claims 13, 25, 54, and 68 have been amended.

Drawings

3. In order to avoid abandonment, the drawing informalities noted on form PTO-948 attached to Paper No. 5, mailed on February 23, 2001, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12, 20, 40-53, 57-60, and 71-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1 and 40, the following limitation is vague: "without the intermediary step of producing hard copies of the pages" the connection between this limitation

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and the body of the claim is not clear [see: claim 1 line 7; claim 40 line --]. Claims 2-12 and 42-53 are rejected based on dependency.

Regarding claims 9 and 20 the following phrase is vague and unclear: "wherein the software comprises software to show a list of headings, **to receive** a list of headings from the list and to retrieve the pages ... the index" [see claim 9 and claim 20]. The sentence is not clear. Is a word missing in the phrase?

Regarding claims 43, 57, and 71, the following phrase is vague and unclear: "but which is not included in the document" [see claims 43, 57, and 71]. The meaning of this phrase is not clear.

Claims 44-46, 58-60, and 72-74 are rejected based on dependency.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 13-39 and 68-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. US Patent 5,963,966 in view of Stern US Patent 6,161,107.

With respect to claim 13, **Mitchell et al.** teaches a persistent electronic storage medium for storing a document in electronic form, the document having a plurality of pages, the medium having written thereon:

(A) plurality of viewable files, each file representing one of the pages of the document and preserving a printed format of said one of the pages [col.7 lines 42-53 “*Each HTML page (typically a separate file, but multiple pages can be accommodated in a single file)*”];

(B) an index representing an organization of the document [note “*indexing*” figure 2; col.2 lines 59-65 “*indexing schemes*”; col.7 lines 32-41; and col.13 line 64 through col.14 line 7]; and

(C) software to view the viewable files and to search through the viewable files in accordance with the index [col.13 line 64 through col.14 line 24; col.1 lines 57-64; col.8 lines 61-67; and col.9 lines 7-32].

Although Mitchell teaches storing a document in electronic form as cited above; he does not explicitly specify the electronic storage medium is of the persistent type. **Stern** teaches that persistence is the mechanism for storing the state of a component that has been captured in one

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format such as by a scanner or fax and converted into another format to be viewed on a monitor for further analysis [see: col.11 lines 30-46; also note figure 7 and abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Stern with Mitchell et al because a persistent storage such as ROM would allow data captured to remain intact when the power to the device is turned off.

8. With respect to claims 14-16:

(Claim 14) wherein the viewable files are bitmap files [Mitchell et al., col.8 lines 19-35].

(claim 15) wherein the bitmap files have a compression applied thereto [Mitchell et al., col.9 line 33 through col.10 line 30; col.11 line 25 through col.12 line 121].

(Claim 16) wherein the compression is a lossy compression [Mitchell et al., note “lossy compression” col.10 lines 12-18; also see col. 11 line 25 through col.12 line 12].

9. With respect to claim 17:

wherein the document is organized under a plurality of headings; and

the index associates each heading with a page on which the heading appears [Mitchell et al., figure 4; also note figures 5 and 8; see col.7 lines 7-26; col.8 lines 5-18].

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10. With respect to claims 18-20:

(Claim 18) wherein the index associates each heading with a first page on which the heading appears [Mitchell et al., col.7 lines 42-67].

(claim 19) wherein the software comprises software to receive a typed name of a heading and to receive the page associated with that heading in the index [Mitchell et al., figure 5].

(Claim 20) wherein the software comprises software to show a list of headings, to receive a selection of a heading from the list and to retrieve the page associated with the heading in the index [Mitchell et al., figure 5 note table of contents].

11. With respect to claims 21 and 22:

(Claim 21) wherein the software is written in a device-independent language and
(Claim 22) wherein the device-independent language is JAVA [See: Stern col.10 line 47 through col. 11 line 23].

Although Mitchell et al. teaches the invention as cited above, they do not specify that the software is written in a device-dependent language. Stern teaches that the software is written in JAVA a device-independent language. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mitchell and Stern because the system architecture provides a framework for interaction between different objects over the Internet by using HTTP Web servers and existing web browsers. Also the technology of the JAVA language enables one to communicate with other applications over the World Wide Web.

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12. With respect to claims 23 and 24:

(Claim 23) wherein the software is written to run within a World Wide web browser ...

(Claim 24) wherein a distribution file for the World wide Web browser is written on the medium [Mitchell et al., col.6 line 63 through col.7 line 14].

13. With respect to claim 25:

(A) a persistent electronic storage medium having written thereon [see Stern: col.11 lines 30-46; also note figure 7 and abstract];

(i) a plurality of viewable files, each viewable file representing one of the pages of the document and preserving a printed format of said one of the pages [Mitchell, col.7 lines 42-53 *“Each HTML page (typically a separate file, but multiple pages can be accommodated in a single file”;*

(ii) an index representing an organization of the document [Mitchell, note *“indexing”* figure 2; col.2 lines 59-65 *“indexing schemes”*; col.7 lines 32-41; and col.13 line 64 through col.14 line 7; and

(iii) software to view the viewable files and to search through the viewable files in accordance with the index [Mitchell, col.13 line 64 through col.14 line 24; col.1 lines 57-64; col.8 lines 61-67; and col.9 lines 7-32]; and

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(B) a computer for accessing the medium, running the software and allowing the user to interact with the software [see: Mitchell et al., col.13 line 64 through col.14 line 24; col.1 lines 57-64; col.8 lines 61-67; and col.9 lines 7-32].

Although Mitchell teaches storing a document in electronic form as cited above; he does not explicitly specify the electronic storage medium is of the persistent type. Stern teaches that persistence is the mechanism for storing the state of a component that has been captured in one format such as by a scanner or fax and converted into another format to be viewed on a monitor for further analysis [see: col.11 lines 30-46; also note figure 7 and abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Stern with Mitchell et al because a persistent storage such as ROM would allow data captured to remain intact when the power to the device is turned off.

14. With respect to claims 26-28:

(Claim 26) wherein the viewable files are bitmap files [Mitchell, col.8 lines 19-35].

(claim 27) wherein the bitmap files have a compression applied thereto [Mitchell, col.9 line 33 through col.10 line 30]

(Claim 28) wherein the compression is a lossy compression [Mitchell, col.10 lines 12-18; col.11 line 25 through col.12 line 12].

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15. The limitations of claims 29-35 have been addressed above in claims 17-24; therefore they are rejected under the same rationale.

16. With respect to claims 36-39:

(Claim 36) the medium is installed on a server of a network; and
the computer is connected to the network to access the medium on the server ... (Claim 37)
wherein the network is a local area network ... (Claim 38) wherein the network is a virtual private
network ... (Claim 39) wherein the network is the Internet [Note Mitchell et al cover figure and
background of the invention col.1; the medium being installed on a network server or LAN is all
within the scope of both Mitchell and Stern].

17. The limitations of claims 68-84 have been addressed above in claims 13-24 and 25-28,
except for the following: a reverse side viewable file, highlighting, and viewing additional
information such as a bill [Mitchell, col.9 lines 30-32, special formats col.7 lines 42-53; a browser
is used on the network with the ability to link to additional material see figures 3, 5, 7, and 9A].

18. Claims 54-63, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Mitchell et al. US Patent 5,963,966 in view of Barrett et al. US Patent 4,918,588.

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With respect to claims 54-63, 66 and 67, **Mitchell et al.** teaches an electronic storage medium for storing a page of a document in electronic form ... highlighting information representing a position of the selected item on the page ... [Mitchell et al., figure 5, col.7 line 6 through col.8 line 36]. Although Mitchell et al. teaches the invention as cited above he does not specifically teach a print queue. **Barrett et al.** teaches a print queue [see: figure 3 element (344, and 346); col.11 line 20 through col.12 line 20]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mitchell et al. and Barrett et al. because it would allow hard copies of the electronic documents to be printed.

19. Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. US Patent 5,963,966 in view of Barrett et al. US Patent 4,918,588 as applied to claim 54 and further in view of Stern US Patent 6,161,107.

Although Mitchell et al. and Barrett et al teach the invention substantially as cited in claim 54, with respect to claims 64 and 65, they do not specify that the software is written in a device-dependent language. Note claims 64 and 65: “wherein the software is written in device-independent language” and (claim 11) “wherein the device-independent language is JAVA” [See: Stern col.10 line 47 through col. 11 line 23].

Stern teaches that the software is written in JAVA a device-independent language. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mitchell, Barrett et al., and Stern because the system architecture provides a framework for

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interaction between different objects over the Internet by using HTTP Web servers and existing web browsers. The technology of the JAVA language enables one to communicate with other applications over the World Wide Web.

Allowable Subject Matter

20 Claims 1-12 and 40-53 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

21. In the response Applicant argued the following: The prior art fails to disclose the ability to place a document into an electronic format for viewing without requiring a hard copy of the document.

In response, this statement “without requiring a copy of the document” is not understood. Note new citation supra. The present invention depicts in Figure 2 element 211 a “capture/electronic directory packager host” process; this process or step is a standard format in capturing or scanning electronic information. It is unclear from the claim and the disclosure as to what is meant by the term without requiring a hard copy of the document.

Mitchell does not obtain a document from electronic storage such that a print queue where data has been converted into a format appropriate for printing as cited.

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In response to this argument the rejection of claims 1-12 and 40-53 has been dropped; the prior art fails to teach the combined elements of independent claims 1 and 40.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta Robinson whose telephone number is (703)308-7565. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM. If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached at (703) 305-9790.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)746-7239, (for formal communications; please mark "EXPEDITED PROCEDURE") **Or:** (703)746-5657, (for informal or draft communications, please label "PROPOSED" or "DRAFT"). Hand delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-9600.



GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson

Primary Examiner

February 21, 2003